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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
YOR920030398US1 (8728-647)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number	Filed
	10/677,933	October 1, 2003
on _____	First Named Inventor	
Signature_____	Richard H. Boivie	
	Art Unit	Examiner
Typed or printed name _____	2132	Almeida, Devin E.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.   48,909
Registration number _____.

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

Nathaniel T. Wallace
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Typed or printed name

516-692-8888
_____
Telephone number

May 8, 2008
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S):   Boivie et al.   DOCKET: YOR920030398US1 (8728-647)

SERIAL NO.:   10/677,933   GROUP ART UNIT: 2132

FILED: October 1, 2003   EXAMINER: Almedia, Devin E.

FOR: **COMPUTING DEVICE THAT SECURELY RUNS AUTHORIZED SOFTWARE**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Examiner:

In response to the Advisory Action dated April 23, 2008 and the Final Office Action mailed February 8, 2008, Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and a Pre-Appeal Brief Request For Review Form (PTO/SB/33).

REMARKS

Please consider the following reasons for this Pre-Appeal Brief Request for Review.

Claims 11, 13, 14, 16-19, and 22-28 are pending. Reconsideration of the rejections in view of the remarks is respectfully requested. Only rejections pertinent to independent claims are addressed herein.

Claims 11, 13, 14, 16, 18 and 22-26 have been rejected under 35 U.S.C. 102(b) as being unpatentable over <u>Sudia</u> et al. (USPAN 2001/0050990). The Examiner stated essentially that <u>Sudia</u> teaches all of the limitations of Claims 11, 13, 14, 16, 18 and 22-26.

Claims 11, 22 and 23 are the independent claims.

Claims 11 and 22 claim, *inter alia*, "<u>reading a certificate including a first public key into a protected memory</u>; <u>validating said certificate with a second public key permanently stored on said processor</u>; reading a signed authorized code into said protected memory, wherein said protected memory is cryptographically protected; preparing to execute said signed authorized code from the protected memory by <u>verifying a digital signature used to sign said signed authorized code in accordance with said first public key</u>." Claim 23 claims, *inter alia*, "a processor in signal communication with said protected memory for preparing to execute said signed authorized code from the protected memory by verifying that a digital signature contained in said signed authorized code is original in accordance with a first public key stored in said protected memory, said first public key validated by a second public key permanently stored on said processor."

<u>Sudia</u> teaches a cryptographic system with a key escrow feature (see Abstract). <u>Sudia</u>

does not teach "preparing to execute said signed authorized code from the protected memory by verifying a digital signature used to sign said signed authorized code in accordance with said first public key" as claimed in Claims 11 and 22 nor "a processor... verifying that a digital signature contained in said signed authorized code is original in accordance with a first public key stored in said protected memory, said first public key validated by a second public key permanently stored on said processor" as claimed in Claim 23. Sudia teaches that new or additional firmware code is signed using a manufacturer's signature. Sudia teaches that the device verifies the manufacturer's signature using the public signature key of the manufacturer (see paragraph [0248], second to last sentence). Respectfully, the manufacturer's signature of Sudia is not analogous to the claimed first public key. That is, Sudia does not teach that the manufacturer's signature is used to verify a digital signature of code; the function of verification is performed in every instance using with the public signature key of the manufacturer. Thus, Sudia does not teach the validation of a first public key using the public signature key of the manufacturer, the first key which is then used for verifying digital signatures, essentially as claimed. Consider the following:

Sudia teaches at paragraph [0249] that a method 1) verifies a 3rd party signature (associated with code) using a manufacture's certificate then 2) verifies the manufacturer's certificate using a manufacturer's public key. The claimed invention 1) validates a certificate (associated with a 1st public key) using a 2nd public key permanently stored in a processor and then 2) verifies authorized code using the 1 public key. Sudia *verifies the code with a certificate* - Sudia does not verify the code using a key, much less a key permanently stored on a processor, therefore Sudia fails to teach all the claimed limitations.

Therefore, Sudia fails to teach all the limitations of Claims 11, 22 and 23.

For at least the foregoing reasons, there is believed to be clear error in the rejection of Claims 11, 22, and 23. Claims 13, 14, 16-19 depend from Claim 11. The dependent claims are believed to be allowable for at least the reasons given for Claim 11. Claims 15, 20 and 21 have been cancelled. The Examiner's reconsideration of the rejection is respectfully requested.

Claims 17, 19, 27 and 28 have been rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Sudia</u> in view of <u>Morgan</u> et al. (USPN 6,185,685). The Examiner stated essentially that the combined teachings of <u>Sudia</u> and <u>Morgan</u> teach or suggest all of the limitations of Claims 17, 19, 27 and 28.

Claims 17 and 19 depend from Claim 11. Claims 27 and 28 depend from Claim 23. The dependent claims are believed to be allowable for at least the reasons given for the respective independent claims. Reconsideration of the rejection is respectfully requested.

For the forgoing reasons, the application, including Claims 11, 13, 14, 16-19, and 22-28, is believed to be in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

Dated: May 8, 2008

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